

page 2 of the Action, “These claims are now being rejected under 35 U.S.C. 101 because they no longer have [sic] an embodiment that doesn’t fall within the claims of the reference patent (see MPEP page 800-20, col. 2, section A).” This rejection and its supporting reasoning are respectfully traversed.

Applicant respectfully submits that the Examiner has not applied the correct legal standard in making the same invention double patenting rejection. The Examiner’s paraphrase of MPEP.804.IIA is incorrect and has led the Examiner into legal error. The true test is not whether the claims in this application claim no embodiments not claimed by the cited patent’s claims; the test is whether the rejected claims in this application are identical in scope to claims in the cited patent.

The relevant portion of the MPEP provision upon which the Examiner relies reads as follows:

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. “Same invention” means *identical* subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984 [sic, 1894]); *In re Vogel*, 422 F2d. 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F2d. 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F2d. 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a “halogen” substituent is not identical to or substantively the same as a claim reciting the same compound except having a “chlorine” substituent instead of the halogen, because “halogen” is broader than “chlorine.” On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of “36 inches” defines the same invention as the claim reciting the same widget having the length of “3 feet.”

The Examiner’s paraphrase of the correct legal statement in the MPEP fails to take into account the legal requirement for same invention double patenting echoed by the MPEP that the claims

of the cited patent be *identical* in scope to claims in the application in the sense that embodiments which would literally infringe one claim would literally infringe the other *and vice versa*.

The same invention double patenting rejection made by the Examiner in the pending Action should be withdrawn because the claims are not cross-readable as required by the law. That is, there is no claim in the cited patent that is identical in scope to any of the rejected claims *or vice versa*. Each of the claims in this application is either broader or narrower than any corresponding claim in the cited patent. As to each pair of a claim in this application and a claim in the cited patent, there is at least one embodiment that would literally infringe the patent claim and not the application or vice versa. For this reason, the same invention double patenting rejection should be withdrawn.

Applicant also notes for the record that the legal test as enunciated by the Examiner would convert any obviousness-type double patenting rejection where the cited patent claims a genus and the claims at hand claim a species which would be anticipated by the genus into a same invention double patenting situation. It could not be questioned that in this situation there is no same invention double patenting, yet the species claims of the application at hand would cover no embodiment that is not within the scope of the claims of the cited patent.

Finally, applicant notes that the terminal disclaimer already of record disposes of any concern that the grant of a patent on this application would unduly extend the monopoly of the cited patent.

In light of the foregoing, early action in the form of a Notice of Allowance is solicited.

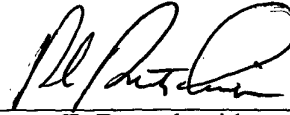
In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge

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Respectfully submitted,

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By:



Barry E. Bretschneider
Registration No. 28,055

Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 300
McLean, Virginia 22102-3915
Telephone: (703) 760-7743
Facsimile: (703) 760-7777